UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,844	09/26/2001	Joseph E. Wilkes	APP 1304-US	9329

9941	7590	09/29/2006	

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EXAMINER
QURESHI, AFSAR M

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/963,844	WILKES ET AL.
	Examiner	Art Unit
	Afsar M. Qureshi	2616

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2006*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 August 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Response to Amendment

1.   This Office Action is responsive to Amendments/Remarks received on 8/15/2006.

Response to Arguments

2.   Applicant's arguments filed on 8/15/2006 have been fully considered but they are

not persuasive.

Applicant argued that the cited prior art, Proctor et al. (US 6,708,036) is not a

valid prior art, because (i) *proctor '036 is a 'common inventor in these two applications'*,

and (ii) *'...is entitled to receive the benefit of the earlier filing date'* (page 8 of

REMARKS).

Examiner contends that the cited art is a proper prior art. As to (i), Proctor '036 is

not a common inventor of the two applications. Paul Zablocky is the common inventor.

Telcordia Technologies, Inc. are the common assignee however, Proctor '036 is the

other inventive entity. As to (ii), Examiner note that an earlier filing date has not been

claimed for a Domestic benefit (35 U.S.C. 120, MPEP 201.06 [c]) within the later of 4

months from the actual filing date or 16 months from the filing date of the prior

application (see 37 CFR 1.78 (a)(2)(ii) wherein reference to early filed application must

have been made in the application data sheet or in the first sentence of the specification

Applicant argued that the cited art, Proctor '036 does not teach or suggest the

limitation *"the second base station automatically identifying the first base station"* . The

Examiner maintains that the cited references of Proctor '036 teach configuration of the

packet network interconnecting the base stations (col. 5, lines 55-57) and col. 10, lines

39-40 teach automatic configuration of the packet network. The pending claims must be

given their broadest reasonable interpretation (MPEP § 2111.01)

3.   **The text of those sections of Title 35, U.S. Code not included in this action**

can be found in a prior Office action.

4.   Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Proctor

et al. (US 6,708,036).

Proctor et al. discloses a communication system comprising the following features:

regarding claim 1, 1. A method for communicating in a system that includes at least a

first base station (Fig. 3, Base Station 110_1) connected to a packet network (Fig. 3,

Internet 340; Fig. 4, 1P network 480), the first base station (Fig. 3, Base Station 110_1)

serving a first cell (Fig. 2, cell 430), said method comprising: connecting a second base

station (Fig. 3, Base Station 110_3) to the packet network (Fig. 3, Internet 340; Fig. 4,

1P network 480); the second base station (Fig. 3, Base Station 110_3) automatically

(column 5, lines 55-57; column 10, lines 39-40) identifying the first base station (Fig. 3,

Base Station 110_1); receiving, at the first base station (Fig. 3, Base Station 110_1),

communications from a wireless device in the first cell (Fig. 2, cell 430) served by the

first base station (Fig. 3, Base Station 110_1); and handing off the wireless device from

the first cell (Fig. 2, cell 430) to a second cell (Fig. 2, cell 470) served by the second

base station (Fig. 3, Base Station 110 3) by a two way exchange of information between

the first base station (Fig. 3, Base Station 110_1) and the second base station (Fig. 3,

Base Station 110_3); regarding claim 2, the first base station (Fig. 3, Base Station

110_1) and the second base station (Fig. 3, Base Station 110 3) exchanging information

over the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480) to determine a

coverage area (column 3, lines 51-62) for the second cell (Fig. 2, cell 470) served by the

second base station (Fig. 3, Base Station 110_3); regarding claim 3, wherein the step of

the second base station (Fig. 3, Base Station 110_3) identifying the first station

includes: the second base station (Fig. 3, Base Station 110_3) transmitting to a carrier

database (Fig. 3, Carrier Database 350) a message requesting addresses for other

base stations connected to the packet network (Fig. 3, Internet 340; Fig. 4, IP network

480); the carrier database (Fig. 3, Carrier Database 350) transmitting an address for the

first base station (Fig. 3, Base Station 110 i) to the second base station (Fig. 3, Base

Station 110 3); and the second base station (Fig. 3, Base Station 110_3) transmitting a

message to the first base station (Fig. 3, Base Station 110_1) using the address for the

first base station (Fig. 3, Base Station 110 1); regarding claim 4, the second base

station (Fig. 3, Base Station 110_3) transmitting a message to a central database

requesting an address for the carrier database (Fig. 3, Carrier Database 350); and the

central database, in response to receiving the message from the second base station

(Fig. 3, Base Station 110 3), transmitting an address for the carrier database (Fig. 3,

Carrier Database 350) to the second base station (Fig. 3, Base Station 110_3);

regarding claim 5, wherein the step of the second base station (Fig. 3, Base Station

110_3) identifying the first base station (Fig. 3, Base Station 110 1) includes: the second

base station (Fig. 3, Base Station 110 3) transmitting a broadcast message on the

packet network (Fig. 3, Internet 340; Fig. 4, IP network 480); and the first base station

(Fig. 3, Base Station 110_1) transmitting a reply message to the second base station

(Fig. 3, Base Station 110_3) in response to receiving the broadcast message; regarding

claim 6, wherein the wireless device includes a computer; regarding claim 7, wherein

the computer includes a personal digital assistant PDA; regarding claim 8, wherein the

wireless device uses the mobile Internet protocol IP to send the communication to the

first base station (Fig. 3, Base Station 110_1); regarding claim 9, wherein the first base

station (Fig. 3, Base Station 110 1) connects to the packet network (Fig. 3, Internet 340;

Fig. 4, IP network 480) via an Ethernet compatible interface; regarding claim 10, a first

base station (Fig. 3, Base Station 110 1) that controls communications with one or more

wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in a first cell (Fig.

2, cell 430); a second base station (Fig. 3, Base Station 110 3) that controls

communications with one or more wireless devices (Fig. 4, wireless device 420a, 420b,

420c, ..., 420n) in a second cell (Fig. 2, cell 470); and a packet network (Fig. 3, Internet

340; Fig. 4, IP network 480) connecting the first base station (Fig. 3, Base Station 110

1) and the second base station (Fig. 3, Base Station 110 3); wherein the first base

station (Fig. 3, Base Station 110_1) automatically (column 5, lines 55-57; column 10,

lines 39-40) identifies the second base station (Fig. 3, Base Station 110_3) after being

connected to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480); and

wherein the first base station (Fig. 3, Base Station 110_1) and the second base station

(Fig. 3, Base Station 110_3) engage in a two way information exchange over the

network to hand off (column 5, lines 31-45) one or more of the wireless devices (Fig. 4,

wireless device 420a, 420b, 420c, ..., 420n) in the first cell (Fig. 2, cell 430) from the first

cell (Fig. 2, cell 430) to the second cell (Fig. 2, cell 470); regarding claim 11, wherein the

first base station (Fig. 3, Base Station 110_1) is further capable of engaging in a two

way exchange of information with the second base station (Fig. 3, Base Station 110_3)

to determine a coverage area (column 3, lines 51-62) for the first cell (Fig. 2, cell 430);

regarding claim 12, wherein the first base station (Fig. 3, Base Station 110_1) further

transmits to a carrier database (Fig. 3, Carrier Database 350) a message requesting

addresses for other base stations connected to the packet network (Fig. 3, Internet 340;

Fig. 4, IP network 480), receives from the carrier database (Fig. 3, Carrier Database

350) an address for the second base station (Fig. 3, Base Station 110 3), and transmits

a message to the second base station (Fig. 3, Base Station 110_3) using the address

for the second base station (Fig. 3, Base Station 110_3); regarding claim 13, wherein

the second base station (Fig. 3, Base Station 110_3) further transmits a message to a

central database requesting an address for the carrier database (Fig. 3, Carrier

Database 350), receives from the central database the address for the carrier database

(Fig. 3, Carrier Database 350), and transmits a message to the carrier database (Fig. 3,

Carrier Database 350) using the address for the carrier database (Fig. 3, Carrier

Database 350); regarding claim 14, wherein the first base station (Fig. 3, Base Station

110_1) further transmits a broadcast message on the packet network (Fig. 3, Internet

340; Fig. 4, IP network 480), and receives a reply message from the second base

station (Fig. 3, Base Station 110_3) in response to the broadcast message; regarding

claim 15, wherein at least one of the wireless devices (Fig. 4, wireless device 420a,

420b, 420c, ..., 420n) includes a cellular phone; regarding claim 16, wherein at least

one of the wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) includes

a computer; regarding claim 17, wherein the computer includes a personal digital

assistant PDA; regarding claim 18, wherein the wireless device communicates with the

first base station (Fig. 3, Base Station 110 1) using mobile Internet protocol IP;

regarding claim 19, wherein the first base station (Fig. 3, Base Station 110_1) connects

to the packet network (Fig. 3, Internet 340; Fig. 4, IP network 480) via an Ethernet

compatible interface; regarding claim 20, a base station for communicating with a

wireless device, comprising: a network interface that connects to a packet network (Fig.

3, Internet 340; Fig. 4, IP network 480); an antenna interface that connects to an

antenna for communicating with one or more wireless devices (Fig. 4, wireless device

420a, 420b, 420c, ..., 420n) in a first cell (Fig. 2, cell 430) served by the base station; a

memory that includes: a program (column 3, lines 59-62) for automatically (column 5,

lines 55-57; column 10, lines 39-40) identifying other base stations, and a program

(column 3, lines 59-62) for engaging in a two way information exchange with one of the

other base stations to hand off (column 5, lines 31-45), from the first cell (Fig. 2, cell

430) to a second cell (Fig. 2, cell 470) served by the other base station, one or more of

the wireless devices (Fig. 4, wireless device 420a, 420b, 420c, ..., 420n) in the first cell

(Fig. 2, cell 430); and a processor that executes the program (column 3, lines 59-62).

See column 1-10.

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Afsar M. Qureshi whose telephone number is (571) 272

3178.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ahmad Matar can be reached on (571) 272 7488. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AFSAR QURESHI
PRIMARY EXAMINER

9/27/2006